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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/396,531	09/15/1999	RANDALL A. ADDINGTON	99-1001	7582

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EXAMINER

PIERCE, WILLIAM M

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 12/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/396,531

Applicant(s)

ADDINGTON ET AL.

Examiner

William M Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 33-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

WILLIAM M. PIERCE  
PRIMARY EXAMINER

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***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 11/29/02 has been entered.

***Specification***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "26" has been used to designate both an overleaf on pg. 19 and a limiting means on pg. 21. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim33-58 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The subject matter courts have found to be outside the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena. See, e.g., Rubber-Tip Pencil Co. v. Howard, 87 U.S. (20 Wall.) 498, 507 (1874). In the instant case, the claims33, 40, 42,43,46-52, 55 and 56 are directed to the natural phenomena of the forces that interact during of the delivery of a bowling ball. Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly v. Morse, 56 U.S. (15 How.) 62, 112-14 (1853). In the instant case, the claims recite nothing more than the physical characteristics of the forces that act between a finger shield and a bowling ball while a player is bowling. Further held is that products found in nature will not be considered to be patentable subject matter under 35 USC 101 and/or 102. An article of manufacture or compsiton of matter occurring in nature will not be considered patentable unless given a new form, quality, properties or combination not present in the original article w exisiting in nature in accordance with existing law. See Funk Bros. Seed Co. v. Kalo Inoculant Co., 333 U.S. 127, 76 USPQ 280 (1948), Ex parte Grayson,

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51 USPQ 413 (Bd. App. 1941). Here there exists no new form in finger protectors and the forces that interact are naturally occurring in nature and not considered patentable.

***Claim Rejections - 35 USC § 112***

Claims 37 and 40-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 37 and 44, the structure required by a "glove finger enclosure" is unclear. The structure of such a phrase must clear so that one can determine the metes and bounds of the claim. In claims 40 and 42, the scope of "maximum natural force" is indefinite. The term maximum relates to the intended use, by the strength of an individual, by the delivery of the ball and the weight of the ball. Such a variable is subjective. <sup>again</sup> Claim 43 is inapt in that it fails to positively recite structure such that one can determine the metes and bounds of the claim. Currently the claim is only narrative with functional recitations that fail to further limit the elements in the previously recited claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 33, 34, 36, 38-43 and 45-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Fowble.

As to claim 33, Fowble shows a finger pad shield **A** with an open end at **e** as shown in fig. 4, a first surface indicated by **b** in fig. 2, a second surface at **d** as indicated in fig. 4. The second surface **d** clearly opposes the first surface **b** and a fastener **a**. The functional limitation pertaining to the intended use such as "for protecting a finger pad from the force" as used in the preamble, "adapted for insertion..." in para. )d and "wherein a force produce in the release..." do not distinguish over the art in a apparatus claim. . If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body

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and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation"); *Kropa v. Robie*, 187 F.2d at 152, 88 USPQ2d at 480-81 (preamble is not a limitation where claim is directed to a product and the preamble merely recites a property inherent in an old product defined by the remainder of the claim. As to claim 34 and 36 respectively, the fastener a is a strap, considered a "ring" and a "glove" finger encloser. As to claims 38, 39, 45 and 53, strap a is capable as functioning as a "limit means" and is considered a "raised surface" when the limitations in the claim are given their broadest reasonable interpretation. As to claims 40, 41, 46-48, 54, 55 and 57, the preamble and paragraph a) are considered shown for the reasons discussed above with respect to claim 33. As to paragraph b) and claims 49, 50, 52 and 56, the finger shield of Fowble is considered substantially "more rigid material" (pg. 1, ln. 35). The shield of the prior art is inherently capable of resisting deformation from a force of a bowling ball during such an intended use. As to claims 42 and 51, the "range within the limit of muscular skeletal development" is the amount of force applied from 0 to where a person can no longer increase the force exerted on an object. Such is inherent in Fowble. It is clear to one skilled in the art of the forces applied and transmitted against forces such as acceleration, gravity and momentum during the delivery of a bowling ball down an alley. However, it has been clearly held that a property or a scientific explanation of the prior art's functioning does not negate the fact that the prior art inherently possessed the claimed element. "Insufficient prior understanding of inherent properties of a known composition does not defeat a finding of anticipation" *Atlas Powder Co. v. Ireco Inc.*, 19 F.3d 1342, 51 USPQ 2d 1943 (Fed. Cir. 1999). As to claim 43, Fowble inherently is capable of spreading a force uniformly over a contact area. More specifically with respect to claims 46-56 and 58, which extensively use means plus function language in attempts to define structure. Fowble shows the function of placing a finger in the shield and having forces exerted between a users finger and the shield be the result of performing a task. These forces between the finger and the shield "form a contact area", "spread force produced" during the task (as recited in claims 46, 48 and 51), spread the fore "uniformly" (claim 47), resist deformation by the materials properties (claims 49, 50, 52 and 56) and spreading over a "widest area" (claim 55).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 35, 37, 44 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowble in view of Pratt.

As to claims 35 and 58, adjustable straps in finger shields and hand protectors in general are old and well known to secure an apparatus so one can achieve a desired fit. As to claims 37 and 44, Fowble fails to discuss any parts of a glove with respect to the use of his finger shield. Pratt shows combining finger inserts with gloves in order to combine the benefits of the insert with those of a gloved hand. To have included the insert of Fowble in a glove would have been obvious in order to protect the finger as well as the hand as a result of the benefits of the glove.

### ***Conclusion***

Applicant's arguments with respect to claim 33-58 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address [bill.pierce@USPTO.gov](mailto:bill.pierce@USPTO.gov) or at telephone number (703) 308-3551.

Any inquiry not concerning the merits of the case such as **missing papers, copies, status or information** should be directed to Tech Center 3700 Customer Service Center at (703) 306-5648 where the fax number is (703) 308-7957 and the email is [Customerservice3700@uspto.gov](mailto:Customerservice3700@uspto.gov).

For **official fax** communications to be officially entered in the application the fax number is (703) 305-3579.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.

**WILLIAM M. PIERCE**  
**PRIMARY EXAMINER**